

REMARKS

Applicants respectfully request reconsideration of the instant application in the view of the preceding amendments and/or the following remarks. By this Response, claims 1, 73, 133 and 195 have been amended to provide clarification, better track current business practices, and/or correct minor typographical informalities, and new claim 200 has been added. Applicants submit that support for the amendments and new claim may be found throughout the originally filed specification, drawings and claims and that no new matter has been added by way of this Response. Applicants explicitly reserve the right to add/pursue the claims as originally filed at a later date and/or in one or more continuation applications. Furthermore, Applicants submit that the claims as originally filed are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons. Claims 1-7, 9-12, 14, 73-80, 133-140 and 195-200 are currently pending.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 5, 9-12, 73, 77, 80, 133, 137 140, 195 and 198-199 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Tavor, et al (U.S. Patent no. 6,553,347; hereinafter "Tavor"). Though Applicants traverse this rejection and submit that the cited reference fails to discuss or render obvious every element of the pending claims, Applicants have amended independent claims 1, 73, 133 and 195 to provide clarification and better track current business practices. Applicants maintain that the original claims are patentably distinct from the cited reference and explicitly reserve the right to add/pursue the claims as originally filed at a later date and/or in one or more continuation applications.

Amended independent claim 1 recites, *inter alia*,

A method for using a computer to facilitate an on-line bounce back transaction, comprising:

...
receiving a seller acceptance of said conditional purchase offer for said first product or service and subsequently receiving a bounce back offer associated with the first product or service to acquire a second product or service as part of an independent bounce back transaction with a hyperlink to a cobranded web site; and
...

Applicants submit that Tavor fails to discuss or render obvious at least this element of independent claim 1. Tavor's system is directed to "conducting 'one to one' commercial negotiations" for the sale of goods, wherein "the system may offer the user several presents or benefits in order to secure the sale" (Tavor, col. 2 lines 9-25). In response to Applicant's previous arguments concerning the deficiencies of Tavor with respect to Applicants' claims (see, e.g., May 28, 2008 Response, p. 31 ¶ 1 to p. 32 ¶ 1), the pending rejection alleges with respect to Tavor that "at some point during the negotiations, either initially or during the course of the negotiations multiple conditional purchase offers and multiple bounce backs may exist and also new negotiations" (August 20, 2008 Office Action, p. 3, ¶ 1). Applicants respectfully traverse this argument and submit that Tavor's system, directed to providing incentives for customers to accept a negotiated position of a seller in a negotiated transaction for a particular good, does not discuss or render obvious at least "receiving a seller acceptance of a conditional purchase offer for said first product or service and subsequently receiving a bounce back offer associated with the first product or service," as recited in independent claim 1. Once a sale of a good is agreed to in Tavor's system, no further incentive is needed or provided with respect to that good. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to how and specifically where Tavor allegedly discusses "receiving a seller acceptance of a conditional

purchase offer for said first product or service and subsequently receiving a bounce back offer associated with the first product or service," as recited in independent claim 1.

Applicants further submit that the pending rejection has impermissibly grouped together pluralities of claims in common rejections that are not equally applicable to all claims in the groups. MPEP § 707.07 (d) prescribes that "[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." (emphasis added). By way of example only, Applicants note that the pending rejection has grouped together claims 1, 73, 133, 195 and 199 in a common rejection (August 20, 2008 Office Action, p. 3, § 1). However, the rejection is clearly not "equally applicable to all claims in the group." For example, claim 199 recites "wherein the bounce back offer is generated based on the acceptance of said conditional purchase offer." This claim element is not recited in claims 1, 73, 133 and 195 and is never addressed by the pending rejection, and yet the pending rejection groups claim 199 in a common rejection with claims 1, 73, 133 and 195. As a result of this impermissible grouping, Applicants are unclear as to how the Examiner has alleged correspondences between claim elements and aspects of the cited reference. MPEP § 706 recites that, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Applicants submit that, by impermissibly grouping claims under a common rejection that is not equally applicable to all claims in the group, the pending rejection has not clearly articulated the rejection. Accordingly, Applicants respectfully request that, should the Examiner maintain the rejection, that each claim be addressed individually, with specific correspondences shown between claim elements and aspects of the cited references.

Applicants further submit that, by failing to address claim limitations, the pending rejection has not made a *prima facie* showing of anticipation. By way of example only, Applicants

note that the pending rejection has not addressed the elements of claim 199, which recited, *inter alia*, "wherein the bounce back offer is generated based on the acceptance of said conditional purchase offer." The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. Accordingly, should the Examiner maintain the rejection, Applicants respectfully request that every claim element be addressed.

Although of different scope than independent claim 1, submit that independent claim 73 is patentable over Tavor for at least similar reasons as discussed above identifying deficiencies in Tavor with regard to independent claim 1. For example, amended independent claim 73 recites, *inter alia*,

A computer device for facilitating an on-line bounce back transaction, comprising:

...

(ii) receive a seller acceptance of said conditional purchase offer for said first product or service and subsequently receive a bounce back offer associated with the first product or service to acquire a second product or service as part of an independent bounce back transaction with a hyperlink to a cobranded web site; and

...

Applicants respectfully submit that at least these claim elements from independent claim 73 are not discussed or rendered obvious by Tavor, which discusses providing benefits as incentives to conclude an electronic negotiation, as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than independent claim 1, submit that independent claim 133 is patentable over Tavor for at least similar reasons as discussed above identifying deficiencies in Tavor with regard to independent claim 1. For example, amended independent claim 133 recites, *inter alia*,

A computer readable medium for facilitating an on-line bounce back transaction, comprising:

...
code executable by the processor for receiving a seller acceptance of said conditional purchase offer for said first product or service and subsequently receive a bounce back offer associated with the first product or service to acquire a second product or service as part of an independent bounce back transaction with a hyperlink to a cobranded web site; and
...

Applicants respectfully submit that at least these claim elements from independent claim 133 are not discussed or rendered obvious by Tavor, which discusses providing benefits as incentives to conclude an electronic negotiation, as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than independent claim 1, submit that independent claim 195 is patentable over Tavor for at least similar reasons as discussed above identifying deficiencies in Tavor with regard to independent claim 1. For example, amended independent claim 195 recites, *inter alia*,

A processor-implemented method for facilitating an independent on-line bounce back transaction spawned from an initial transaction, comprising:

...
receiving a seller acceptance of said conditional purchase offer for said first product or service and subsequently receiving a bounce back offer associated with the first product or service, wherein the bounce back offer is configured to initiate a subsequent transaction to acquire a second product or service with a hyperlink to a cobranded web site; and
...

Applicants respectfully submit that at least these claim elements from independent claim 195 are not discussed or rendered obvious by Tavor, which discusses providing benefits as incentives to conclude an electronic negotiation, as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Furthermore, Applicants submit claims 2-7, 9-12, 14, 74-80, 134-140 and 196-199, which are directly or indirectly dependent from independent claims 1, 73, 133 and 195, are also not anticipated by Tavor's system for at least similar reasons to those discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

Rejections under 35 USC § 103

Claims 2-3, 74-75, 134-135 and 196 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tavor, et al in view of Official Notice; claims 4, 6-7, 76, 78-79, 136, 138-139 and 197 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tavor, et al., in view of Microsoft Office 2000 Professional Edition (hereinafter, "MS Office 2000"); and claim 14 has been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tavor, et al., in view of Logan, et al. (US Patent no. 6,199,076; hereinafter "Logan").

Applicants respectfully traverse these rejections and submit that a *prima facie* case of obviousness has not been established and that the pending claims are patentably distinct from the cited references and Official Notice, taken alone or in combination, for at least the following reasons.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that the pending rejection has failed to properly set forth the differences in the claims over the applied references and to explain why the claimed invention

would have been obvious to one of ordinary skill in the art at the time the invention was made by failing to provide sufficient objective rationale for modifying the references, by dissecting claims, and by not providing a discussion of the level of ordinary skill in the art.

By way of example only, Applicants note that the pending rejection alleges, "it would have been obvious to one of ordinary skill in the art, at the time the invention was made to sell airline tickets in the invention of Tavor et al. ('347) for the benefit of maximizing sales of products and services" (see, e.g., August 20, 2008 Office Action, p. 6, § 2). Applicants respectfully traverse this argument and submit that the pending rejection has applied impermissible hindsight in alleging rationales that are overly general and provide no specific link between the cited art and the proposed modifications. The alleged rationale in the above example, "for the benefit of maximizing sales of products and services," is very general and does not clearly point beyond the reference to indicate the specific modifications alleged by the Examiner to be obvious to one of ordinary skill in the art at the time of Applicants' invention. In another example, the pending rejection alleges, "it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email or voicemail as is most convenient to the user" (August 20, 2008 Office Action, p. 8, § 4). Applicants submit that merely stating an alleged advantage of a particular modification of the cited references does not constitute a sufficient articulation of the reasons for modifying those references to support a rejection under 35 U.S.C. § 103. MPEP § 2141(III) states, *inter alia*, "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious," and that, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." As no "clear articulation" of the reasons for the specific, proposed modifications has been provided, Applicants submit that a *prima facie* case of obviousness has not been established and respectfully request reconsideration and withdrawal of this basis of rejection. Should the

Examiner maintain the rejection, Applicants respectfully request that a "clear articulation" of objective rationales for modifying the references be provided that is drawn from the references themselves and points to a link between each reference and the specific, proposed modifications.

Applicants further submit that the pending rejection has not even alleged that the claims as wholes would have been obvious to one of ordinary skill in the art at the time of Applicants' invention. MPEP § 2141.02 (I) prescribes, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (original emphasis). That is, the MPEP requires that the Examiner address the obviousness of proposed modifications to the references in respect to the claim as a whole, and not in respect to specific proposed modifications. By way of example only, Applicants note that the pending rejection has alleged, "it would have been obvious to one of ordinary skill in the art, at the time the invention was made to communicate with email for the benefit of maximizing communication options" (August 20, 2008 Office Action, p. 7, § 3). In another example, the pending rejection alleges, "it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email or voicemail as is most convenient to the user" (August 20, 2008 Office Action, p. 8, § 4). Applicants submit that the pending rejection has only addressed the alleged obviousness of "the differences themselves" and has never addressed "whether the claimed invention as a whole would have been obvious," as required, *inter alia*, by MPEP § 2141.02 (I). Applicants therefore submit that the pending rejection has failed to provide sufficient objective rationale for the proposed modification of the references and that a *prima facie* showing of obviousness has not been made. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of the rejection. Should the Examiner maintain the rejection, Applicants respectfully request

clarification as to how the Examiner believes "the claimed invention as a whole would have been obvious" to one of ordinary skill in the art.

Applicants also submit that the pending rejection has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection refers to, "one of ordinary skill in the art," (see, e.g., August 20, 2008 Office Action, p. 6, § 2) but has provided no indication or discussion of which art is being referred to or the level of ordinary skill associated therewith. The rejection's reference to "the art" is overly general, is unclear and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicants submit that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicants respectfully request that, if the Examiner maintains this rejection, the Examiner indicate which art is being referred to, discuss the level of ordinary skill in that art at the time of the invention and clarify how the claimed subject matter would have been obvious to one possessing that level of skill.

Applicants further submit that none of the other cited references, nor the Examiner's Official Notice, remedy the deficiencies identified above with respect to Tavor in relation to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-7, 9-12, 14, 73-80, 133-140 and 195-200, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserve the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-067US1. In the event that an additional extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-067US1.

Respectfully Submitted,
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